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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,883	04/24/2001	Masao Mougi	16869P-025800US	6133
20350 7590 12/13/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER SHERR, CRISTINA O	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 12/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	09/841,883		MOUGI ET AL.	
	Examiner		Art Unit	
	Cristina Owen Sherr		3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-22 and 28-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-22 and 28-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/21/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to applicant's amendment filed August 13, 2007. Claims 23-27 have been canceled. Claims 18, 19, 20, 21, 22, 28 29, 31, and 32 have been amended. Claims 18-22 and 28-32 are currently pending in this case.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on September 21, 2006 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Response to Arguments

3. Applicant's arguments filed August 13, 2007 have been fully considered but they are not persuasive.

4. Applicant argues, regarding claim 18, as currently amended, (but also in with respect to claims 19-22 and 28-32, for brevity and economy), that nothing in the cited prior art suggests, teaches, or discloses wherein "the seller computer requests input of client information, product information and license program information from the purchaser computer ... the purchaser computer transfers the client information, the product information and the license program information to the seller computer; the seller computer transfers a first license request including the product information and the license program information, but not the client information, to the license-issuing computer; the license-issuing computer issues a trial license key for the program specified by the license program information."

5. With respect to claim 18, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case we note that a "system is an apparatus." *Ex parte Fressola* 27 USPQ2d 1608, 1611 (B.P.A.I. 1993) (citations omitted). Additionally, "[c]laims in apparatus form conventionally fall into the 35 U.S.C. §101 statutory category of a 'machine.'" *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907). Therefore, it is the Examiner's position that Applicant's system claims are "product," "apparatus," or more specifically, "machine" claims. In this case, we note that requesting input and transferring information from one computer to another are not structural differences, but rather differences in function. In other words, these differences have to do with what the apparatus does rather than what it is. Thus the said "features" do not distinguish the claim 18 over the prior art. The same is true of claims 19, 20, 21 and 22.

6. With respect to claims 28-32, applicant is making the same arguments as with respect to claim 18.

7. Applicant argues that nothing in the cited references discloses, teaches or suggests "a purchaser computer, a seller computer, and a license-issuing computer".

8. Examiner respectfully disagrees and directs attention to Ginter, at figure 2. Figure 2, discloses the VDE rights distributor (106) which acts as a seller computer, the VDE content user (112) which acts as the purchaser computer, and the VDE content creator (102), which acts as the license issuing computer.

9. Applicant argues that nothing in the cited references discloses, suggests or teaches "the seller computer requests input of client information, product information and license program information from the purchaser computer ... the purchaser computer transfers the client information, the product information and the license program information to the seller computer; the seller computer transfers a first license request including the product information and the license program information, but not the client information."

10. Examiner respectfully disagrees and directs attention to Ginter, at fig 2, wherein the the purchaser computer of VDE content user is sending financial information (payments) to the VDE administrator. That information is sent in response to the rules and controls (110) sent by the seller computer (106) since no one would send such such information just "because". Once the payment and report information get back to the seller computer., the seller computer sends the digital item/license to the purchaser.

11. With respect to the trial licenses as indicated in the amended version of the claims, Horstmann discloses, at, e.g. col 1 ln 58 – col 2 ln 19, wherein through “try and buy”, the buyer gets a limited license and when the limited license expires, the buyer may then pay to get a less limited license. This is a trial license issued by the seller computer. It would be obvious to combine the teachings of Ginter and Horstman in order to facilitate “try and buy” in a secure manner.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 18-22 and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al (US 5,892,900) in view of Horstmann (6,009,401).

14. Regarding claim 18 –

Ginter (See abstract, Figs. 1, 2, 53a, Col. 43, lines 20-55 (user might require a method that summarizes usage information for reporting to a clearinghouse (e.g. billing information) in a way that does not convey confidential, personal information regarding detailed usage behavior), Col. 47, lines 20-55, Col. 196, lines 45-67, Col. 197, lines 1-5, (thus-may be used to implement privacy filters by, for example, preventing certain confidential user information from being written to data structures that will be reported to third parties)) disclose means for a server to issue a license to a client upon verification

and issuing a license key for a product by means of a communication network involving multiple parties and restrictions placed on the transmission of user data substantially as claimed. The differences between the above and the claimed invention is the use of specific license by merchant computer and authentication. It is noted that the server (See Fig. 1) is equivalent to a license-issuing computer.

15. Horstmann (See Fig. 2,3, Col. 3, lines 1-15, Col. 4, lines 55-65) shows license by merchant computer. Further, as above, Horstmann discloses, at, e.g. col 1 ln 58 – col 2 ln 19, wherein through “try and buy”, the buyer gets a limited license and when the limited license expires, the buyer may then pay to get a less limited license. This is a trial license issued by the seller computer .

16. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ginter et al because the license elements are conventional functional equivalents with respect to the claim limitations and authentication is a necessary component of validation and use.

17. Regarding claim 19 –

Ginter et al (See abstract, Figs. 1, 2, 53a, Col. 43, lines 20-55 (user might require a method that summarizes usage information for reporting to a clearinghouse (e.g. billing information) in a way that does not convey confidential, personal information regarding detailed usage behavior), col. 47, lines 20-55, col. 196, lines 45-67, Col. 197, lines 1-5 (thus may be used to implement privacy filters by, for example, preventing certain confidential user information from being written to data structures that will be reported to third parties)) disclose means for a server to issue a license to

a client upon verification and issuing a license key for a product by means of a communication network involving multiple parties and restrictions placed on the transmission of user data substantially as claimed. The differences between the above and the claimed invention is the use of specific license by merchant computer and authentication. It is noted that it is believed that the server (See Fig. 1) are equivalent to a license-issuing computer.

18. Horstmann (See Fig. 2,3, Col. 3, lines 1-15, Col. 4, lines 55-65) shows license by merchant computer.

19. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ginter et al because the license elements are conventional functional equivalents with respect to the claim limitations.

20. Regarding claim 20 –

Ginter et al (See abstract, Figs. 1, 2, 53a, Col. 43, lines 20-55 (user might require a method that summarizes usage information for reporting to a clearinghouse (e.g. billing information)) in a way that does not convey confidential, personal information regarding detailed usage behavior), col. 47, lines 20-55, col. 196, lines 45-67, Col. 197, lines 1-5 (thus may be used to implement privacy filters by, for example, preventing certain confidential user information from being written to data structures that will be reported to third parties)) disclose means for a server to issue a license to a client upon verification and issuing a license key for a product by means of a communication network involving multiple parties and restrictions placed on the transmission of user data substantially as claimed. The differences between the above

and the claimed invention is the use of specific license by merchant computer and authentication. It is noted that the server (See Fig. 1) is equivalent to a license-issuing computer.

21. Horstmann (See Fig. 2,3, Col. 3, lines 1-15, Col. 4, lines 55-65) shows license by merchant computer. Further, as above, Horstmann discloses, at, e.g. col 1 ln 58 – col 2 ln 19, wherein through “try and buy”, the buyer gets a limited license and when the limited license expires, the buyer may then pay to get a less limited license. This is a trial license issued by the seller computer .

It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ginter et al because the license elements are conventional functional equivalents with respect to the claim limitations.

22. Regarding claim 21-

Ginter et al (See abstract, Figs. 1, 2, 53a, Col. 43, lines 20-55 (user might require a method that summarizes usage information for reporting to a clearinghouse (e.g. billing information) in a way that does not convey confidential, personal information regarding detailed usage behavior), col. 47, lines 20-55, col. 196, lines 45-67, Col. 197, lines 1-5 (thus may be used to implement privacy filters by, for example, preventing certain confidential user information from being written to data structures that will be reported to third parties)) disclose means for a server to issue a license to a client upon verification and issuing a license key for a product by means of a communication network involving multiple parties and restrictions placed on the transmission of user data substantially as claimed. The differences between the

above and the claimed invention is the use of specific license by merchant computer and authentication. It is noted that it is believed that the server(See Fig. 1) are functionally equivalent to a license-issuing computer.

23. Horstmann (See Fig. 2,3, Col. 3, lines 1-15, Col. 4, lines 55-65) shows license by merchant computer. Further, as above, Horstmann discloses, at, e.g. col 1 ln 58 – col 2 ln 19, wherein through “try and buy”, the buyer gets a limited license and when the limited license expires, the buyer may then pay to get a less limited license. This is a trial license issued by the seller computer .

24. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ginter et al because the license elements are conventional functional equivalents with respect to the claim limitations.

25. Regarding claim 22 –

Ginter et al (See abstract, Figs. 1, 2, 53a, Col. 43, line's 20-55 (user might require a method that summarizes usage information for reporting to a clearinghouse (e.g. billing information) in a way that does not convey confidential, personal information regarding detailed usage behavior), col. 47, lines 20-55, col. 196, lines 45-67, Col. 197, lines 1-5 (thus may be used to implement privacy filters by, for example, preventing certain confidential user information from being written to data structures that will be reported to third parties)) disclose means for a server to issue a license to a client upon verification and issuing a license key for a product by means of a communication network involving multiple parties and restrictions placed on the

transmission of user data including storage which is the functional equivalents of the claim limitations.

26. Further, as above, Horstmann discloses, at, e.g. col 1 ln 58 – col 2 ln 19, wherein through “try and buy”, the buyer gets a limited license and when the limited license expires, the buyer may then pay to get a less limited license. This is a trial license issued by the seller computer . It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ginter et al because the license elements are conventional functional equivalents with respect to the claim limitations.

27. Regarding claim 28 –

Ginter et al (See abstract, Figs. 1, 2, 53a, Col. 43, lines 20-55 (user might require a method that summarizes usage information for reporting to a clearinghouse (e.g. billing information) in a way that does not convey confidential, personal information regarding detailed usage behavior), col. 47, lines 20-55, col. 196, lines 45-67, Col. 197, lines 1-5 (thus may be used to implement privacy filters by, for example, preventing certain confidential user information from being written to data structures that will be reported to third parties)) disclose method for a server to issue a license to a client upon verification and issuing a license key for a product by means of a communication network involving multiple parties and restrictions placed on the transmission of user data substantially as claimed. The differences between the above and the claimed invention is the use of specific license by merchant computer and

authentication. It is noted that the server (See Fig. 1) is equivalent to a license-issuing computer.

28. Horstmann (See Fig. 2,3, Col. 3, lines 1-15, Co1. 4, lines 55-65) show license by merchant computer. Further, as above, Horstmann discloses, at, e.g. col 1 ln 58 – col 2 ln 19, wherein through “try and buy”, the buyer gets a limited license and when the limited license expires, the buyer may then pay to get a less limited license. This is a trial license issued by the seller computer. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ginter et al because the license elements are conventional functional equivalents with respect to the claim limitations.

29. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ginter et al because the license elements are conventional functional equivalents with respect to the claim limitations and authentication is a necessary component of validation and use.

30. Regarding claim 29 –

Ginter et al (See abstract, Figs. 1, 2, 53a, Col. 43, lines 20-55 (user might require a method that summarizes usage information for reporting to a clearinghouse (e.g. billing information) in a way that does not convey confidential, personal information regarding detailed usage behavior), col. 47, lines 20-55, col. 196, lines 45-67, Col. 197, lines 1-5 (thus may be used to implement privacy filters by, for example, preventing certain confidential user information from being written to data structures that will be reported to third parties)) disclose method for a server to issue a license to

a client upon verification and issuing a license key for a product by means of a communication network involving multiple parties and restrictions placed on the transmission of user data substantially as claimed. The differences between the above and the claimed invention is the use of specific license by merchant computer and authentication. It is noted that the server (See Fig. 1) is equivalent to a license-issuing computer.

31. Horstmann (See Fig. 2,3, Col. 3, lines 1-15, Col. 4, lines 55-65) shows license by merchant computer. Further, as above, Horstmann discloses, at, e.g. col 1 ln 58 – col 2 ln 19, wherein through “try and buy”, the buyer gets a limited license and when the limited license expires, the buyer may then pay to get a less limited license. This is a trial license issued by the seller computer. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ginter et al because the license elements are conventional functional equivalents with respect to the claim limitations.

32. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ginter et al because the license elements are conventional functional equivalents with respect to the claim limitations and authentication is a necessary component of validation and use.

33. Regarding claim 30 –

Ginter et al (See abstract, Figs. 1, 2, 53a, Col. 43, lines 20-55 (user might require a method that summarizes usage information for reporting to a clearinghouse (e.g. billing information) in way that does not convey confidential, personal information

regarding detailed usage behavior), col. 47, lines 20-55, col. 196, lines 45-67, Col. 197, lines 1-5 (thus may be used to implement privacy filters by, for example, preventing certain confidential user information from being written to data structures that will be reported to third parties)) disclose means for a server to issue a license to a client upon verification and issuing a license key for a product by means of a communication network involving multiple parties and restrictions placed on the transmission of user data including license which is the equivalent of the claim limitations.

34. Regarding claim 31, Ginter et al (See abstract, Figs. 1, 2, 53a, Col. 43, lines 20-55(user might require a method that summarizes usage information for reporting to a clearinghouse (e.g. billing information) in a way that does not convey confidential, personal information regarding detailed usage behavior), col. 47, lines 20-55, col. 196, lines 45-67, Col. 197, lines 1-5 (thus may be used to implement privacy filters by, for example, preventing certain confidential user information from being written to data structures that will be reported to third parties)) disclose method for a server to issue a license to a client upon verification and issuing a license key(including trial use) for a product by means of a communication network involving multiple parties and restrictions placed on the transmission of user data substantially as claimed. The differences between the above and the claimed invention is the use of specific license by merchant computer and authentication. It is noted that the server (See Fig. 1) is equivalent to a license-issuing computer.

35. Horstmann (See Fig. 2,3, Col. 3, lines 1-15, Col. 4, lines 55-65) show license by merchant computer. Further, as above, Horstmann discloses, at, e.g. col 1 ln 58 – col 2 ln 19, wherein through “try and buy”, the buyer gets a limited license and when the limited license expires, the buyer may then pay to get a less limited license. This is a trial license issued by the seller computer. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ginter et al because the license elements are conventional functional equivalents with respect to the claim limitations.

36. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ginter et al because the license elements are equivalents with respect to the claim limitations and authentication is a necessary component of validation and use.

37. Regarding claim 32 –

Ginter et al (See abstract, Figs. 1, 2, 53a, Col. 43, lines 20-55 (user might require a method that summarizes usage information for reporting to a clearinghouse (e.g. billing information), in a way that does not convey confidential, personal information regarding detailed usage behavior), col. 47, lines 20-55, col. 196, lines 45-67, Col. 197, lines 1-5 (thus may be used to implement privacy filters by, for example, preventing certain confidential user information from being written to data structures that will be reported to third parties)) disclose means for a server to issue a license to a client upon verification and issuing a license key for a product by means of a communication network involving multiple parties and restrictions placed on the

transmission of user data including license which is the equivalent of the claim limitations.

38. Further, as above, Horstmann discloses, at, e.g. col 1 ln 58 – col 2 ln 19, wherein through “try and buy”, the buyer gets a limited license and when the limited license expires, the buyer may then pay to get a less limited license. This is a trial license issued by the seller computer. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ginter et al because the license elements are conventional functional equivalents with respect to the claim limitations.

39. Examiner's Note: Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific claim limitations within the individual claim and other passages and figures may apply as well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Conclusion

40. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

41. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

42. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571-272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

43. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

44. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

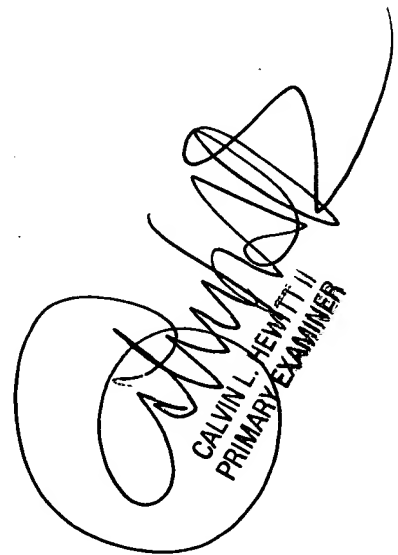
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Cristina Owen Sherr
Patent examiner, AU 3621



CALVIN L. HEWITT II
PRIMARY EXAMINER